

REQUEST FOR INTERVIEW:

Applicant respectfully request an in-person interview with the Examiner and Supervisor to discuss the outstanding rejection and Applicant's response thereto.

REJECTIONS UNDER 35 USC 103

Claims 1-14 stand rejected under 35 U.S.C. §103(a) as being obvious over Kanno, U.S. Patent No. 5,602,567, in view of Lundberg, U.S. Patent No. 5,738,527. This rejection is respectfully traversed.

By way of review and as an example, independent claim 1 sets forth a "display apparatus, comprising: a display screen displaying thereon image data sent from a main apparatus; a memory unit storing therein screen protecting image data; and a display control unit displaying the screen protecting image data stored in said memory unit on said display screen under such a condition that the main apparatus is not actually operated for a predetermined time period."

Further, the display screen, the memory unit, and the display control unit are contained in a frame that is independent from a frame containing the main apparatus.

The Office Action has again argued that it would have been obvious to modify the display monitor of Kanno to store screen protecting image data in an internal memory since Lundberg discloses the use of screen savers.

In our previous response, Applicant pointed out that Lundberg only discloses storing the screen saver program in a computer storage device, while the Office Action indicated that it would be obvious to include the same in the memory of the display apparatus of Kanno. In addition, Applicant also pointed out that there is no indication that monitor control CPU 14 of Kanno would be able or designed to run the screen saver program, that both Lundberg and Kanno appear to be teaching away from the presently claimed invention, and that only the present application provides the motivation, suggestion, or need to store "screen protecting image data" in a memory of a display monitor similar to that in Kanno.

In response to Applicant's arguments, the Office Action merely summarized the same in saying that "[a]pplicant argues that there is no suggestion in either Kanno or Lundberg that a screen saver program be stored in the memory of a display. Contrary to applicant's arguments, it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what

the references as a whole would have suggested to one of ordinary skill in the art." The Examiner cites several cases to support his statement.

However, it is respectfully submitted that the Office Action is incorrect in setting forth of what a prima facie obviousness rejection entails and what recent cases have specifically set forth for the same.

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(Emphasis added).

In addition, the mere fact that the prior art may be modified in the manner as set forth in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

Further, a "[r]ejection of [a] patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating and reversing a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO that upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the Board had held that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

Thus, regardless of what the Examiner proposes the cases cited in the Office Action indicate, the Office Action is required to include evidenced motivation and point out where the same can be derived from.

In the outstanding rejection, the Office Action is asserting the two cited references to read on the claimed invention when neither reference suggests or desires the same. In addition, neither reference proposes anything like the present application, which requires the

memory storing the claimed screen protecting image data to be separate from the main apparatus, i.e., the computer attached to the display monitor. Rather, as pointed out previously, both references actually teach away from the same, since both references use a computer and associated memory to control and store screen saver programs, with the computer transmitting the screen saver information to the display. Thus, the cited references can only disclose saving screen saver information in a main apparatus separate from a memory storing the screen saver protecting image data.

Similarly, current case law specifically indicates that a combination of references would not be obvious if their combination would not work, which is an argument that would appear to be quite relevant considering how the Examiner is attempting to combine the two references. The monitor disclosed in Kanno is not physically configured to display data stored in the cited RAM of the display frame. Thus, even if the screen saver program described in Lundberg were stored in the RAM of the display from of Kanno, it would be impossible to display the screen saver in the display screen of Kanno.

Lastly, as noted above, to set forth a prima facie obviousness rejection, the rejection itself must include evidenced motivation, particularly point out where that motivation is disclosed, and how that cited motivation would lead one skilled in the art to modify Kanno as suggested in the Office Action. Rather, the Office Action merely points out that Kanno discloses a display with an internal memory, and then indicates that because Lundberg teaches allowing a user to "create his or her own custom data base of units of information" in a screen saver program, it would have been obvious to include such a screen saver program in the display memory of Kanno.

However, the rejection still fails to present the required motivation why one skilled in the art would recognize that Kanno either could run a screen saver program from memory in the display or would store such a screen saver program in the same memory. Only the present application provides this leap.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 1-14 be withdrawn and claims 1-14 be allowed.

CONCLUSION:

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Response, please charge the same to our Deposit Account No. 19-3935.

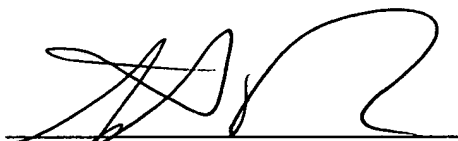
Respectfully submitted,

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11/26/02

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